

REMARKS

By this amendment, claims 1, 4-8, 10-11, 14-28, 45, 47, 49-52, and 54-58 have been amended. Claims 30-42 and 59-61 have been canceled without prejudice or disclaimer. Claims 1-29 and 43-58 are pending in the application. Applicants reserve the right to pursue the original claims and other claims in this and other applications.

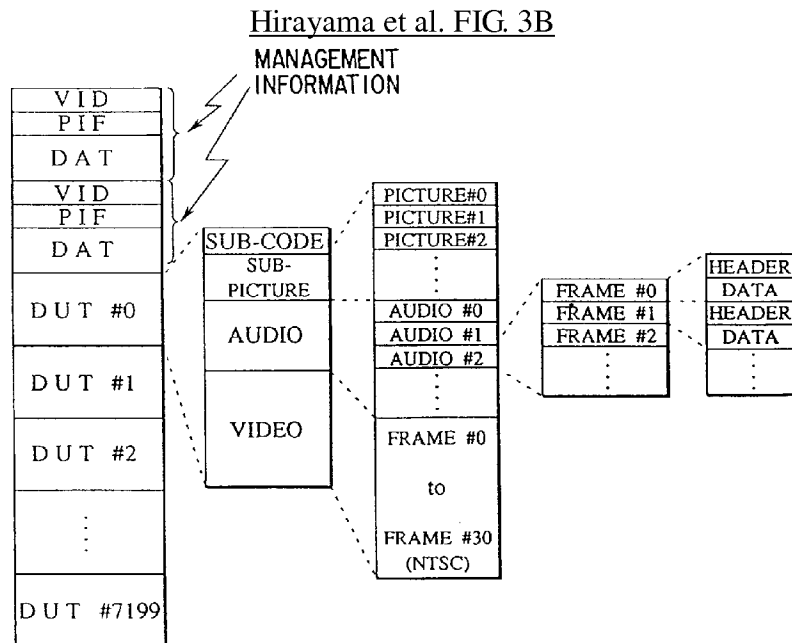
Claims 1, 4-8, 10-11, 14-28, 45, 47, 49-52, and 54-58 have been amended to correct grammatical and typographical errors unrelated to any rejection in the Office Action, and should not require further consideration or search.

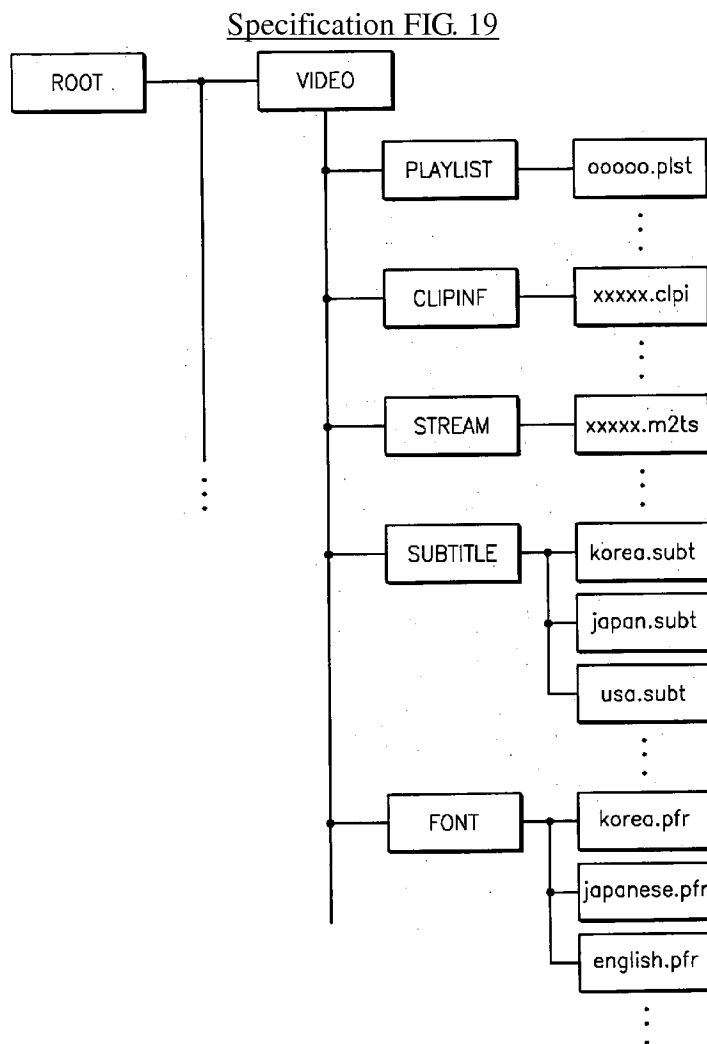
Claims 1-5, 7-8, and 12-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hirayama et al. (US 6,128,434). This rejection is respectfully traversed.

Claim 1 recites an information storage medium comprising, *inter alia*, “a plurality of clips comprising recording units in which the video data are stored; and text data for subtitles which are recorded separately from the plurality of clips” (emphasis added). Applicants respectfully submit that Hirayama et al. does not disclose at least these features.

To the contrary, Hirayama et al. discloses in FIG. 3B (reproduced below on page 12) that each sub-picture containing the subtitle information is stored together in the same data unit DUT as its associated video data. This is markedly different from the file structure disclosed in the present claimed invention, as shown in FIG. 19 of the specification (reproduced below on page

13), in which the clips are stored in a file folder “STREAM” and the subtitles are stored in a separate file folder “SUBTITLE.” Applicants respectfully submit that Hirayama et al. does not disclose, teach, or suggest at least “a plurality of clips comprising recording units in which the video data are stored; and text data for subtitles which are recorded separately from the plurality of clips,” as recited in claim 1.





Since Hirayama et al. does not disclose all of the features of claim 1, claim 1 is not anticipated by Hirayama et al. Claims 2-5, 7-8, and 12-13 depend from independent claim 1 and are patentable at least for the reasons mentioned above, and on their own merits. Applicants respectfully request that the 35 U.S.C. § 102(b) rejection of claims 1-5, 7-8, and 12-13 be withdrawn and the claims allowed.

Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirayama et al. in view of Seng et al. (US 2001/0025320). This rejection is respectfully traversed. Claims 9-11 depend from independent claim 1 and are patentable at least for the reasons mentioned above, and on their own merits. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 9-11 be withdrawn and the claims allowed.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirayama et al. in view of Nonomura et al (US 6,046,778; hereinafter “Nonomura ‘778”). This rejection is respectfully traversed. Claim 6 depends from independent claim 1 and is patentable at least for the reasons mentioned above, and on its own merits. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claim 6 be withdrawn and the claim allowed.

Claims 14-21, 25-26, 28-29, and 43-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mimura et al. (US 6,345,147) in view of Nonomura ‘778, and further in view of Nonomura et al. (US 6,574,419; hereinafter “Nonomura ‘419”). This rejection is respectfully traversed. None of Mimura et al., Nonomura ‘778, nor Nonomura ‘419, even when considered in combination, teaches or suggests all of the features of independent claims 14, 43, or 51.

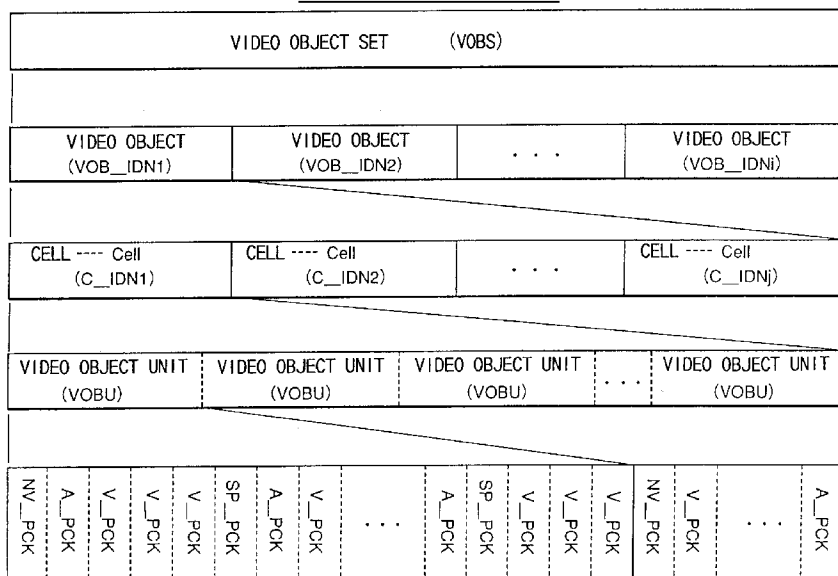
Claim 14 recites, *inter alia*, “an information storage medium on which video data is recorded, the video data being coded and divided into clips that are recording units and recorded in a plurality of clips and on which text data for subtitles that are formed with data of a plurality of languages and are overlappable as graphic data with an image based on the video data, the text

data being recorded separately from the clips” (emphasis added). Claims 43 and 51 recite similar features. As claims 43 and 51 were rejected for the same reasons as for claim 14, the amendments to claims 43 and 51 should require no further consideration or search. Applicants respectfully submit that Mimura et al., Nonomura ‘778, and Nonomura ‘419, even when combined, fail to teach or suggest at least these features.

To the contrary, Mimura et al., which was cited at page 8 of the Office Action for teaching that the text data is recorded separately from the clips, actually teaches that “[o]ne object unit (VOBU) consists of one navigation pack (NV_PCK), more than one audio pack (A_PCK), more than one video pack (V_PCK), and more than one sub-picture pack (SP_PCK).” Col. 4, ln. 23-26; FIG. 4 (reproduced below on page 16). In other words, each subtitle in the sub-picture pack is stored with its associated video pack in a single object unit (VOBU). This is markedly different from the file structure disclosed in the present claimed invention, as shown in FIG. 19 of the specification (reproduced above on page 13), in which the clips are stored in a file folder “STREAM” and the subtitles are stored in a separate file folder “SUBTITLE.” Applicants respectfully submit that Mimura et al. does not disclose, teach, or suggest at least that the text data is recorded separately from the clips or AV data, as recited in claims 14, 43, and 51.

Nor are Nonomura ‘778 or Nonomura ‘419 cited for these features. Thus, Nonomura ‘778 and Nonomura ‘419 do not remedy the deficiencies of Mimura et al.

Mimura et al. FIG. 4



Since Mimura et al., Nonomura ‘778, and Nonomura ‘419 do not teach or suggest all of the features of claims 14, 43, and 51, claims 14, 43, and 51 are not obvious over the cited combination. Claims 15-21, 25-26, 28-29, 44-50, and 52-58 depend, respectively, from independent claims 14, 43, and 51, and are patentable at least for the reasons mentioned above, and on their own merits. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 14-21, 25-26, 28-29, and 43-58 be withdrawn and the claims allowed.

Claims 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mimura et al. in view of Nonomura ‘778, further in view of Nonomura ‘419, and still further in view of Seng et al. This rejection is respectfully traversed. Claims 22-24 depend from independent claim 14 and are patentable at least for the reasons mentioned above, and on their own merits.

In addition, the “requisite prior art suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. . . .” *Eli Lilly & Co. v.*

Teva Pharms. USA, Inc., 2004 U.S. Dist. LEXIS 14724 at *104; 2 *Chisum on Patents*

§ 5.04[1][e][vi]. In the present application, the lack of a reason to combine each of the four references with each of the others, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments.

Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 22-24 be withdrawn and the claims allowed.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mimura et al. in view of Nonomura '778, further in view of Nonomura '419, and still further in view of Official Notice. This rejection is respectfully traversed. Claim 27 depends from independent claim 14 and is patentable at least for the reasons mentioned above, and on its own merits. Furthermore, Applicants traverse the use of Official Notice. "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." M.P.E.P. § 2144.03(A) (emphasis in original). Such documentary evidence is respectfully requested. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claim 27 be withdrawn and the claim allowed.

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

Respectfully submitted,

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